UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CARL P. PEARSON

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Appeal 2007-0754
Application 09/669,087
Technology Center 3700

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Decided: March 30, 2007

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Before MURRIEL E. CRAWFORD, STUART S. LEVY, and LINDA E. HORNER, *Administrative Patent Judges*.

LEVY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a video game system using trading cards. (Specification 3). A video game features characters on the trading cards. A control system carrying out the game controls a screen in accordance with a

1 software program and in accordance with the character information

2 associated with the trading cards selected by the players of the game.

3   Claim 1 is representative of the claims on appeal and reads as follows:

4   1.   A video game system using trading cards,

5 comprising:

6

7   a local electronic game system for use with a video

8 screen for displaying the playing of a selected video game featuring

9 characters on trading cards, the characters having associated character

10 information, including characteristics which define the playing of the

11 game, the electronic game system including a control system for

12 carrying out the video game and controlling the display on the screen

13 in accordance with a stored software program and in accordance with

14 the character information associated with the trading cards selected by

15 the players of the game for use in the game;

16

17   trading cards having characters indicated thereon for

18 playing the video game;

19

20   an identification system for identifying the trading cards

21 selected by players for playing the video game;

22

23   a server control unit for connecting the local electronic

24 game system to a website at a remote location through a global

25 computer network; and

26

27   a processing system at the website for verifying that the

28 players of the video game have the right to use the selected trading

29 cars in the playing of the selected video game, wherein the website

30 includes means for storing information associated with the characters

31 on said trading cards and for downloading said information to the

32 video game control system, which includes means for receiving said

33 downloaded information and which is capable of using said

34 downloaded information and said associated character information

35 from the trading cards to carry out the video game after the selected

1   trading cards have been identified and the player's rights to use the
2   selected trading cards have been verified.
3
4   The Examiner rejected claims 1 to 28 under 35 U.S.C. § 103(a) (2004)
5   as being unpatentable over Peppel in view of Sehr and Pearson.
6   The prior art relied upon by the Examiner in rejecting the claims on
7   appeal is:

8 Pearson	US 5,411,259	May 2, 1995
9 Peppel	US 6,200,216 B1	Mar. 13, 2001
10 Sehr	US 6,325,292 B1	Dec. 4, 2001

11
12   With respect to claims 1-22, Appellant contends (Br. 3-4) that Peppel
13   does not teach that the information stored on the remote website associated
14   with a character on a selected trading card is "downloaded directly into the
15   control system of the local electronic game system." Appellant states that
16   "[t]he character information used in Pepple [sic, Peppel] for carrying out the
17   video game comes into play only from the medium of the ETCs themselves
18   (the trading cards)," whereas Appellant's system is capable of using both
19   downloaded information from a website and information on a trading card to
20   carry out the game. (Id.). Appellant contends (id.) that Sehr does not teach
21   this feature. Appellant further contends (Br. 3-4) that there is no teaching in
22   Peppel of verifying that individual players have the right to use the trading
23   card selected by the player for playing the video game. With respect to
24   claims 23-28 Appellant contends the he has claimed a single, stand-alone
25   configuration of a video game using trading cards, and that the Examiner has
26   not cited any reference which discloses or suggests any such arrangement.
27   (Br. 5-6).

1   The Examiner contends that it would have been obvious to combine Peppel

2   with the security and authentication programs of Sehr and the media

3   structure of Pearson (Answer 5). The motivation provided by the Examiner

4   is that Peppel states that his system is for disassociated consumer media; i.e.,

5   multimedia products that allow customers to browse, create, collect, and

6   exchange, as well as play games (Answer 4).

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8   We AFFIRM-IN-PART.

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10   ISSUE

11   Has Appellant shown that the Examiner erred in holding that the

12   combined teachings and suggestions of Peppel, Sehr, and Pearson would

13   have suggested to an artisan the invention of claims 1-28? With respect to

14   claims 1-22, the issue turns on whether the references teach or suggest

15   verifying that the players have the right to use the selected trading card in

16   the playing of the video game, and whether the prior art teaches or suggests

17   that the website includes means for downloading information associated

18   with the characters on the trading cards to the video game control system, as

19   required by claim 1. With regard to claims 23-28, the issue turns on whether

20   the prior art would have suggested combining the electronic game system,

21   video screen, and trading card reader into a "single, stand-alone unit."

22
23   FINDINGS OF FACT

24   Based upon a preponderance of the evidence, we make the following

25   findings of fact:

4

1	1.	Appellant invented a video game system using characters
2		featured on trading cards. A control system carries out the
3		game in accordance with a stored software program and in
4		accordance with the character information associated with
5		the trading cards selected by the players of the game for use
6		in the game. A website stores information associated with
7		the characters in said trading cards and downloads the
8		information to the video game control system, after the
9		trading cards have been identified and verified, for playing
10		the video game. (Specification 3).
11	2.	Peppel is directed to an electronic trading card. (Peppel, col.
12		1, l.1).
13	3.	The invention of Peppel provides electronic hardware and
14		software architecture for electronic trading cards (ETCs).
15		(Peppel, col. 4, ll. 50-52).
16	4.	Peppel discloses that the components function together as a
17		system that supports activities such as game playing with
18		electronic trading cards. (Peppel, col. 4, ll. 51-58).
19	5.	Peppel discloses that single or multiple ETCs may be copied
20		onto writable media. (Peppel, col. 8, ll. 60-61).
21	6.	ETC adventure games are similar in structure to existing
22		video and computer games except that the ETCs move the
23		action forward and can generate ETCs in the course of a
24		game. (Peppel, col. 10, l. 66-col. 11, l. 3).

1	7.	Sehr is directed to a card system and methods utilizing
2		collector cards. (Sehr, col. 1, ll. 1-2).
3	8.	Sehr discloses that the cardholder can exchange data with
4		remote databases, as well as update or manipulate data
5		stored in the card. (Sehr, col. 3, ll. 42-47).
6	9.	Collector card 11 of Sehr comprises a handheld card device
7		that is used by the cardholder to store collectible
8		information, request various services, and pay for the
9		purchase of goods and services. The collector card includes
10		smart cards that have the shape of credit cards and have an
11		embedded circuit. The collector cards can further include
12		handheld terminals or any pocket-sized computer
13		configurations. The embedded circuits give the cards
14		database storage means, processing means and display
15		means. Card data can be retrieved or loaded into the card by
16		a card read/write device. (Sehr, col. 5, ll. 43-59).
17	10.	In Sehr, biometrics are used to verify if a cardholder is
18		legitimate. (Sehr, col. 6, ll. 15-17).
19	11.	The database of Sehr includes the cardholder identification
20		number. (Sehr, col. 7, ll. 13-16).
21	12.	Full-motion video segments can be retrieved and stored in
22		the card. (Sehr, col. 10, ll. 23-25).
23	13.	The method of Sehr includes verifying the identity of the
24		cardholder. (Sehr, col. 11, ll. 66-67).

1   14.   To ensure that the cardholder in Sehr is entitled to receive

2   the requested service, the identity of the cardholder can be

3   verified. (Sehr, col. 16, l. 66-col. 17, l. 1).

4   15.   Pearson is directed to a video sports game system using

5   trading cards. (Pearson, col. 1, ll. 1-2).

6   16.   In Pearson, trading card elements have input data stored

7   thereon concerning performance information of players in

8   the video game. The information can be read by a card

9   reader. (Pearson, col. 1, ll. 61-64).

10   17.   As shown in figure 1 of Pearson, the monitor 14, card reader

11   22, and control system 12 are separate elements.

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14   PRINCIPLES OF LAW

15   On appeal, Appellant bears the burden of showing that the Examiner

16   has not established a legally sufficient basis for combining the teachings of

17   the applied prior art. Appellant may sustain this burden by showing that,

18   where the Examiner relies on a combination of disclosures, the Examiner

19   failed to provide sufficient evidence to show that one having ordinary skill

20   in the art would have done what Appellant did. *United States v. Adams*, 383

21   U.S. 39, 48, 148 USPQ 479, 482 (1966); *In re Kahn*, 441 F.3d 977, 987-88,

22   78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *DyStar Textilfarben GmbH & Co.*

23   *Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d 1356, 1360-61, 80 USPQ2d

24   1641, 1645 (Fed. Cir. 2006). The mere fact that all the claimed elements or

25   steps appear in the prior art is not per se sufficient to establish that it would

26   have been obvious to combine those elements. *United States v. Adams, id*;

1 *Smith Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51

2 USPQ2d 1415, 1420 (Fed. Cir. 1999).

3   ANALYSIS

4   We begin with claims 1-22. Appellant argues these claims as a group.

5 Accordingly, we select claim 1 as representative of the group. We note at

6 the outset that Appellant does not dispute the combinability of the

7 references, but rather argues to the effect that the combined teachings of the

8 prior art would not result in the claimed invention. From facts 13 and 14 we

9 find that Sehr suggests verifying the identity of the cardholder, as well as

10 verifying that the cardholder is entitled to receive the requested service.

11 However, although Sehr describes downloading full motion video segments

12 that can be retrieved and stored in the card (fact 12), we find no disclosure in

13 Sehr of using the trading cards with video games, and no teaching of this has

14 been pointed to by the Examiner. Nor do we find in Sehr any teaching or

15 suggestion of downloading from a website any information to a video game

16 control system.

17   With respect to Peppel and Pearson, although these references are

18 directed to trading cards used with video games, we find no teaching or

19 suggestion in either reference of downloading from the processing system at

20 the website information associated with the characters on the trading cards,

21 to the video game control system. The Examiner has not pointed to any

22 description in the applied prior art for this claimed feature. In response to

23 Appellant's assertion (Br. 4-5) that this feature is not suggested, the

24 Examiner's response (Answer 7) is that Peppel teaches media and platform

25 independence, and refers to columns 3-5 of Sehr for a teaching of updating a

1   card through a remote database. Firstly, the Examiner's broad reference to

2   columns (instead of col./line) of the reference is not helpful to us in deciding

3   this appeal. Secondly, a description of media and platform independence

4   does not address downloading to the video game control system. Thirdly,

5   the fact the Sehr describes downloading to the card is not a description or

6   suggestion of downloading to the video game control system, because the

7   claims require downloading to the video game control system, not to the

8   trading card.

9   From all of the above, we agree with Appellant that the teachings and

10   suggestions of the prior art fall short of suggesting all of the limitations of

11   claim 1. It follows that we cannot sustain the rejection of claims 1-22.

12   We turn next to claims 23-28. Appellant's arguments are directed to

13   claim 23. Accordingly, we select claim 23 as representative of the group.

14   From fact 9, we find a description in Sehr of the card being a handheld

15   computing device. However, we find no description in Sehr that the card

16   read/write device will be part of the handheld device. However, claim 23 is

17   not specific as to how the components of the game system, display and card

18   reader are integrated into a single, stand-alone unit. In the absence of

19   solving any problem in the art or the recitation of any unobvious structure,

20   we find that to make integral, or in one piece that which was known to be

21   made in plural pieces would have been obvious to an artisan. *See In re*

22   *Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

23   Accordingly, we find that to make the card reader, display and game system

24   as a single, stand-alone unit, would have been within the level of ordinary

25   skill of an artisan. It follows that we are not convinced of any error on the

1   part of the Examiner in rejecting claim 23 under 35 U.S.C. § 103(a) as being

2   unpatentable over the teachings and suggestions of Peppel, Sehr, and

3   Pearson. The rejection of claims 23-28 is sustained.

4

5   CONCLUSION OF LAW

6   Appellant has met his burden of establishing that the Examiner erred

7   in rejecting claims 1-22 under 35 U.S.C. § 103(a). Appellant has not met his

8   burden of showing the Examiner erred in rejecting claims 23-28 under 35

9   U.S.C. § 103(a).

10

11   DECISION

12   The Examiner's rejection of claims 1-22 is reversed. The Examiner's

13 rejection of claims 23-28 is affirmed.

14   No time period for taking any subsequent action in connection with

15 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

16   AFFIRMED-IN-PART

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